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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,090

11/17/2003

Kia Silverbrook

ZG148US

9652

24011

7590

06/03/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER

GORDON, RAQUEL YVETTE

ART UNIT

PAPER NUMBER

2853

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,090

Applicant(s)

SILVERBROOK, KIA

Examiner

Raquel Y. Gordon

Art Unit

2853



-- Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 10/129,503.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/17/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For example, the following term lacks antecedent basis: "the same" (claim 3).

Double Patenting Statutory Basis

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Double Patenting Rejection

Claims 1-11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8 of copending Application No. 10/713089. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

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For example, the following claim limitations are in jeopardy of being double patented:

1. A pagewidth printhead assembly for a printer, the printer having a page width, the assembly comprising: a longitudinal core (claim 1, ln 8); a pagewidth printhead mounted to the core (claim 1, lns 1-2); the pagewidth printhead comprising two or more modular printheads (claim 3/1); the pagewidth printhead being stationary relative to the page width (claim 2/1); the core being contained within an outer laminated shell (claim 2/1), the shell having an effective coefficient of thermal expansion substantially equal to that of the printhead (claim 1, lns 7-8);
2. A printhead assembly according to claim 1, wherein: the core has formed in it one or more ink reservoirs (claim 3/2/1);
3. A printhead assembly according to claim 1, wherein: the laminate of the outer shell is formed from at least three metals laminated together, the laminate having inner and outer layers which are of the same metal (claim 4);
4. A printhead assembly according to claim 1, wherein: the printhead is fabricated from silicon (claim 5);

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5. A printhead assembly according to claim 4, wherein: the printhead is constructed using micro electromechanical techniques (claim 5);
6. A printhead assembly according to claim 1, wherein: the core is an extrusion defining separate ink reservoirs (claim 6);
7. A printhead assembly according to claim 1, wherein: the outer shell is a laminated structure having an odd number of longitudinally extending layers of at least two different metals wherein layers are arranged in a symmetrical arrangement (claim 7/2/1);
8. A printhead assembly according to claim 1, wherein: the modular printheads are positioned end to end along the core (claim 8);
9. A printhead assembly according to claim 1, wherein: the laminated shell comprises two or more different materials, each having a different coefficient of thermal expansion (claim 9)
10. A printhead assembly according to claim 6, wherein: the extrusion comprises adjacent reservoirs which collectively lead to one or more micro mouldings which are carried by the core (claim 3/2/1);

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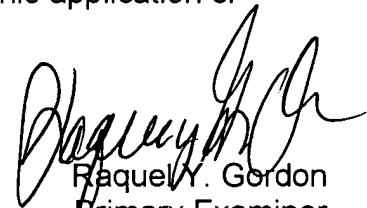
11. A printhead assembly according to claim 9, wherein: the laminated shell comprises outer layers of invar (claim 11).

Contact Information

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Raquel Y. Gordon, whose telephone number is (571) 272-2145. The Examiner can normally be reached on M Tu Th and F 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. A fax number is available upon request.

Any inquiry of a general nature or relating to the status of this application or proceeding may be directed to the Examiner or Supervisor.


Raquel Y. Gordon
Primary Examiner
Art Unit 2853
May 26, 2004

**RAQUEL GORDON
PRIMARY EXAMINER**